



PATENT
Attorney Docket No. 05725.0753-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attention: Mail Stop Appeal Brief-Patents

Commissioner for Patents
P.O. Box 1450
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Siri

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Pursuant to 37 C.F.R. § 41.41, Appellant presents this Reply to the Examiner's Answer dated September 25, 2006. A Request for Oral Hearing is concurrently filed with this Reply Brief.

If any fees are required in connection with the filing of this paper that are not filed herewith, Appellants request that the required fees be charged to Deposit Account No. 06-0916.



Application No.: 09/663,183
Attorney Docket No.: 05725.0753-00

RELATED APPEALS AND INTERFERENCES

In accordance with 37 C.F.R. § 41.37(c)(1)(ii), Appellant advises the Board of Patent Appeals and Interferences of the following pending appeals, interferences, or judicial proceedings which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the instant appeal.

Application No. 09/663,168 (Attorney Docket No. 05725.0754):

A Notice of Appeal was filed January 18, 2006, along with a Pre-Appeal Brief Request for Review. A Notice of Panel Decision from Pre-Appeal Brief Review dated March 1, 2006, was sent informing Appellant to proceed to the Board of Patent Appeals and Interferences. An Appeal Brief for this related application was filed on June 29, 2006. The Examiner's Answer was mailed October 12, 2006.

II. EVIDENCE RELIED UPON

A Supplemental Examiner's Answer was mailed on October 17, 2006. This Supplemental Answer was to "correct defects in the Examiner's Answer mailed on September 25, 200[6] . . . by providing a listing of the evidence being relied on for the rejections (section (8))." Supplemental Answer at 1. Appellant sees no difference between the original "Evidence Relied Upon" section and the subsequent supplemental "Evidence Relied Upon." However, Appellant agrees that the Examiner relies upon WO 99/04750 to Blankenburg et al. (and its translation), and U.S. Patent No. 5,297,566 to Firstenberg.

III. ARGUMENT

A. Independent Claims 1, 50, 98, and 102

1. The Examiner has not made a prima facie case of obviousness because neither Blankenburg nor Firstenberg suggest any desirability for modification

In her Answer, the Examiner continues to argue that “one of ordinary skill in the art would have been motivated to combine the hair-setting polymer of Firstenberg . . . with the hair-setting polymer and composition of Blankenburg . . . with the expectation of forming a composition capable of use in hair styling and hair setting.” Examiner’s Supplemental Answer at 10. To support this contention, the Examiner asserts that “[b]oth the Blankenburg et al. and Firstenberg et al. references teach polymers that are suitable for hair setting compositions.” *Id.* at 9. Following this assertion that both cited references teach hair setting compositions, the Examiner spends a paragraph on each reference detailing their respective teachings of polymers suitable for hair styling. See *id.* at 9-10. Thus, the Examiner attempts to show motivation based on both compositions relating to hair styling or polymers for hair styling.

The Examiner has not shown that Blankenburg and Firstenberg provide motivation for their combination, for the simple reason that they contain no such motivation. In fact, both references, especially Blankenburg, teach away from their combination. A reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must also be considered. See *Bausch & Lomb, Inc. v. Barnes Hind/Hydrocurve, Inc.*, 796 F.2d 443 (Fed. Cir. 1986).

First, as previously argued in the Appeal Brief, not one of the 16 Examples of Firstenberg shows a composition with more than one film-forming polymer. Notably this includes Example 9, which the Examiner relies upon for teaching and providing motivation for the combination of vinylpyrrolidone/vinyl acetate/vinyl propionate copolymers, with another film-forming polymer. Further, Firstenberg teaches more about the mechanical properties of its invention than about the components of the composition used in the method and device. Thus, there is no reason why one of ordinary skill in the art would have been motivated to pick a polymer taught by Firstenberg for combination with another polymer, as the compositions are secondary teachings to the mechanical properties.

Second, also as previously argued, Blankenburg states that “[a]t first, vinyl lactam homopolymers and copolymers were preferred, ***but subsequently polymers containing carboxylate groups have become increasingly important.***” Blankenburg translation at page 1 (emphasis added). Such a statement at the very beginning of Blankenburg’s disclosure indicates that the invention of Blankenburg is a departure from, and an alternative to, vinyl lactam copolymers.

The Examiner attempts to rebut this argument by asserting that Blankenburg “does not actually teach any negative properties or attributes of the vinyl lactam homo and copolymers that would discourage one of ordinary skill in the art from combining a desired hair-setting vinyl lactam polymer with the hair-setting polymer that is the focus of Blankenburg.” Examiner’s Supplemental Answer at 13 (emphasis in original). Appellant respectfully submits that a reference does not need to teach negative properties or attributes in order to be considered as “teaching away.” “A reference may

be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Gurley*, 27 F.3d 551 (Fed. Cir. 1994). The teaching of Blankenburg is that vinyl lactam polymers “were preferred.” Blankenburg translation at page 1 (emphasis added). Since “were” is past tense, one can necessarily infer that, according to Blankenburg, they are no longer preferred or desired.

The Examiner further argues that Blankenburg “does not teach or suggest that the use of prior polymers . . . should be entirely avoided.” Examiner’s Supplemental Answer at 12. Contrary to the Examiner’s assertion, the standard for showing motivation is not satisfied by stating that one of ordinary skill would not “entirely avoid” an element based on the teaching of a reference. Rather, the standard is met only if the references provide some affirmative motivation to result in a particular combination.

In order to support a rejection under 35 U.S.C. § 103, “the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would [actively] select the elements from the cited prior art references for combination in the manner claimed.” *In re Rouffet*, 149 F.3d at 1357, 47 U.S.P.Q.2d at 1458 (Fed. Cir. 1998) (emphasis added). The Examiner cannot pick and choose from a reference only the teachings that suit her purpose.

Finally, even if, *arguendo*, Blankenburg is not construed as “teaching away” from the use of vinyl lactam polymers, it most certainly cannot be construed as providing motivation for their use, as vinyl lactam polymers are part of the art that the teaching of Blankenburg is seeking to avoid.

Accordingly, the Examiner has not and cannot show that there is a suggestion or teaching in the combined references that would have motivated a person of ordinary skill in the art to subsequently combine the disclosures of Firstenberg and Blankenburg. As shown, Firstenberg does not teach the use of vinyl lactam polymers with another film-forming polymer, and Blankenburg teaches using a preferred alternative to vinyl lactam copolymers. There is simply no motivation between the two references to make such a selection.

2. The Examiner has not made a prima facie case of obviousness because *In re Kerkhoven* is not applicable to the present facts

Appellant does not challenge that the cited references teach hair styling products. What Appellant does challenge is the Examiner's conclusion that Blankenburg and Firstenberg provide the requisite motivation to arrive at the presently claimed invention merely because both references describe styling compositions and/or styling polymers. Common subject matter among references does not negate the requirement to show motivation to combine.

The Examiner contends that both cited references "teach that the polymers act as hair-setting and hair-fixing agents. Thus, it follows logically that the two polymers could be combined into a single composition for the purpose of forming a hair setting compositions [sic]." Examiner's Supplemental Answer at 11 (emphasis added). It is well known that the standard in showing obviousness is not whether the references can be combined or modified -- this "does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. § 2143.01 (emphasis added) (citing *In re Mills*, 916 F.2d 680 (Fed Cir. 1990)). See also

In re Gordon, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.") (emphasis added).

At best, the evidence relied upon by the Examiner shows that individual parts of the claimed invention are known. This does not establish a *prima facie* case of obviousness. As held by the Federal Circuit:

Most if not all inventions arise from a combination of old elements . . . However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.

In re Kotzab, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000).

Thus, by law, the fact that styling compositions contain styling polymers does not and cannot in and of itself provide motivation for any and all combinations and substitutions of styling polymers within styling compositions.

The Examiner further ignores the law by misapplying *In re Kerkhoven* to the present facts. The Examiner refuses to accept the holding of *Kerkhoven*, and instead contends that the "essence of the logical argument set forth by [Kerkhoven] is that it is obvious to combine two substances (polymers, compositions, etc.) each of which is taught as being useful for the same purpose, to form a combination that is useful for the purpose." Examiner's Supplemental Answer at 14. This argument lacks factual and legal basis.

No where in the *Kerkhoven* decision does the court hold that the combining of compounds known to be useful for the same purpose in order to form a composition that can be used for the same purpose is *prima facie* obvious. Rather, the facts of the case, which the decision is necessarily based upon, relate to the combination of two compositions, both individually useful for the same purpose, in order to create a third composition, also useful for the same purpose of the first two compositions. See *Kerkhoven*, 626 F.2d at 849, 205 USPQ at 1071. Thus, the Examiner is arguing a standard that would render obvious every cosmetic composition that is comprised of compounds known to be useful in cosmetic compositions. Such a standard was not the holding in *Kerkhoven* and is not the law in determining obviousness. See, e.g., *In re Kotzab* quoted *supra*.

As argued in the Appeal Brief, the literal combination of Blankenburg and Firstenberg would not give rise to the claimed invention. Thus, the Examiner's application of *Kerkhoven* is inapposite to the present case.

B. Dependent Claims 2-33, 38-49, 51-82, and 87-101

As discussed above, the Examiner has not shown and cannot show that one of ordinary skill in the art would have been motivated to combine the elements cited by the Examiner in Blankenburg with Firstenberg, especially in view of the fact that Blankenburg teaches away from such a combination, to arrive at the independently claimed invention. Since the Examiner has not shown the motivation necessary to establish a *prima facie* case of obviousness with respect to the independent claims, she has not established a *prima facie* case with respect to the dependent claims.

As the Examiner has failed to establish a prima facie case of obviousness, the rejection is improper and should be reversed.

IV. CONCLUSION

The Examiner has failed to establish a prima facie case of obviousness at least because the cited references do not provide motivation for, or suggest the desirability of, their combination, as proffered by the Examiner. For the reasons given above, and argued in the previously submitted Appeal Brief, pending claims 1-33, 38-82, and 87-102 are allowable. Thus, Appellant respectfully requests reversal of the Examiner's rejection.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Reply Brief, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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/Louis Troilo/

Dated: November 27, 2006

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